

Notice of Allowability

Application No.

09/757,049

Examiner

David A. Lambertson

Applicant(s)

BERNSTEIN ET AL.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 25 September 2003.
2. ☒ The allowed claim(s) is/are 57-61 and 66-105.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

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EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Carol Gruppi on January 8, 2004.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: specifically, Figure 6 does not indicate panels A-H, which are set forth in the description of Figure 6 in the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The application has been amended as follows:

In the specification please include "now US Patent No. 6,183,961" between "1998," and "which" in the second line of paragraph [0001], in order to update the status of the priority application.

In the Brief Description of Figure 2C, please enter the phrase "of *S. pombe* Cdc5 (SEQ ID NO: 3)" after the phrase "putative activation domain".

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In the claims:

Claim 57. A vector comprising an hCdc5 binding site nucleic acid selected from the group consisting of SEQ ID NO: 13, SEQ ID NO: 14, SEQ ID NO: 15, SEQ ID NO: 16, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22 and SEQ ID NO: 27, operably linked to a nucleic acid encoding a protein of interest.

Claim 59. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 57 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

Claim 82. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 66 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

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Claim 83. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 67 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

Claim 84. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 68 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

Claim 85. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 69 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

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Claim 86. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 70 into said a cell which expresses hCdc5 under ~~conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,~~

thereby expressing a protein of interest in a cell which expresses hCdc5.

Claim 87. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 71 into said a cell which expresses hCdc5 under ~~conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,~~

thereby expressing a protein of interest in a cell which expresses hCdc5.

Claim 88. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 72 into said a cell which expresses hCdc5 under ~~conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,~~

thereby expressing a protein of interest in a cell which expresses hCdc5.

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Claim 89. A method of expressing a protein of interest in a cell which expresses hCdc5 comprising:

introducing the vector of claim 73 into said a cell which expresses hCdc5 under conditions in which the hCdc5 expressed in said cell activates the transcription of said coding sequence for said protein of interest,

thereby expressing a protein of interest in a cell which expresses hCdc5.

In claims 60 and 90-97, please enter the phrase "thereby detecting the presence of hCdc5 in a cell" at the end of the claim. An example claim 60, is set forth below:

Claim 60 A method for detecting the presence of hCdc5 in a cell comprising:

introducing the vector of claim 58 into said cell and detecting the expression of said reporter protein[.],

thereby detecting the presence of hCdc5 in a cell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson, Ph.D.
AU 1636



JAMES KETTER
PRIMARY EXAMINER